



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,444	01/20/2006	Heide-Marie Holzer	SONN:1000	9836
34725	7590	11/30/2007		
CHALKER FLORES, LLP 2711 LBJ FRWY Suite 1036 DALLAS, TX 75234			EXAMINER SNOW, BRUCE EDWARD	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 11/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,444

Applicant(s)

HOLZER ET AL.

Examiner

Bruce E. Snow

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 16-19 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) 25, 26 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 16-19, 27, 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Applicant's election without traverse of Group 3 in the reply filed on 6/12/07 was acknowledged. Subsequently, applicant has added claims 25, 26, and 29 which contain subject matter which was previously withdrawn to a non-elected group. At the time of the restriction applicant did not argue this subject matter was generic to the elected invention. Claims 25, 26, and 29 have been withdrawn to a non-elected invention and upon allowance, must be cancelled.

Response to Arguments

Applicant's arguments filed 10/09/07 have been fully considered but they are not persuasive. Regarding the rejection under 35 U.S.C. 102(e) as being anticipated by Hellberg (2002/0165619), the shaped body for replacing the missing limb is interpreted as the prosthetic device in paragraph 002 including the foot or lower leg of paragraph 003 and the socket shown in figure 4. The shaped body of Hellberg is interpreted as being light weight. All other arguments are non-commensurate with the claims.

Regarding the rejected under 35 U.S.C. 102(b) as being anticipated by Telikicherla (5,651,792), applicant argues that the device is not optical or cosmetic. The term optical is not commensurate with the scope of at least claim 13. It is the Examiner's position that the wearer of the prosthetic leg of Telikicherla would look more natural and aesthetically pleasing than without it, and therefore, is cosmetic. All other arguments are non-commensurate with the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, 16-19, 27, 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13, applicant's intended scope of the term "cosmetic" is indefinite.

Allowable Subject Matter

Claim 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Art Unit: 3738

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 13, 16, 17, 19, 27, 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Hellberg (2002/0165619).

Referring to figure 4, Hellberg teaches:

13. A light prosthesis as a visual substitute for a missing limb, comprising: a shaped body for replacing the missing limb (see a prosthetic device in paragraph 002; see paragraph 003 teaching foot or leg) comprises a socket (at least figure 4) for connecting the prosthesis to a stump of the missing limb, wherein the shaped body is made of a light synthetic material, and that the periphery of the socket for connecting the prosthesis to the stump is variable wherein the prosthesis is cosmetic.

16. (Original) The light prosthesis of claim 13, wherein the length of the socket (2) is variable. The variable length is due to the folds in the rear of the socket as shown.

17. (Original) The light prosthesis of claim 16, wherein the socket (2) is made of an elastic material at least over a partial region of its length, and that the elastic material forms at least one pleat (7) in the partial region to achieve a change in the length of the socket (2).

19. (Original) The light prosthesis of claims 13, wherein the shaped body (1) includes a joint or several joints to replace the joint(s) of the missing limb. See at least paragraph 0003 teaching an entire leg which inherently includes an ankle and possibly a knee joint.

Regarding claims 27, the prosthesis of Hellberg inherent has some short coming as compared to the natural limb, such as movement of the toes or fingers. These shortcomings are interpreted as "non functional".

Claims 28, see at least paragraph 003.

Art Unit: 3738

Claims 13, 16, 19, 27, 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Telikicherla (5,651,792).

Referring to figures 10-11, Telikicherla teaches:

13. (Original) A light prosthesis as a visual substitute for a missing limb, comprising: a shaped body for replacing the missing limb (see at least figure 1) comprises a socket 116 for connecting the prosthesis to a stump of the missing limb, wherein the shaped body is made of a light synthetic material, and that the periphery of the socket for connecting the prosthesis to the stump is variable wherein the prosthesis is cosmetic.

16. (Original) The light prosthesis of claim 13, wherein the length of the socket (2) is variable. Note the end cap 125 can be adjustably attached using straps 126. Also see 9:50 et seq.

19. (Original) The light prosthesis of claims 13, wherein the shaped body (1) includes a joint or several joints to replace the joint(s) of the missing limb. See at least figure 1. Regarding claims 27, the prosthesis of Telikicherla inherently has some short coming as compared to the natural limb, such as movement of the toes or fingers. These shortcomings are interpreted as "non functional".

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3738


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bes



BRUCE SNOW
PRIMARY EXAMINER